

RYSZARD SPRYCHA ET AL.
USSN 09/982,496
REPLY TO THE OFFICE ACTION DATED FEBRUARY 20, 2004
AMENDMENT OF JANUARY 21, 2005

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Purely editorial amendments have been made to claims 10, 15, 19, 24 and 29. A mark-up showing the changes that have been made to these claims using strikethrough and underlining appears above. In claims 10 and 24, Applicants have corrected the spelling of "triethanolamine." In claim 15, Applicants have corrected the preamble to the singular form to be consistent with the body of the claim. In claim 19, Applicants have corrected the spelling of "water." Finally, in claim 29, Applicants have added a period at the end of the claim. Applicants submit that these

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amendments do not introduce new matter. An early notice to that effect is earnestly solicited.

Claims 1-29 were rejected under 35 USC § 112, first paragraph, as containing new matter. In response, Applicants submit that the “non-fluorescent” pigment limitation finds ample support in the original specification, and, therefore, its use in the claims does not introduce new matter. The Examiner says there is “no support” in the original disclosure for this limitation, but original claims 3 and 17 specify a number of pigments that are, in fact, non-fluorescent pigments. Consequently, there can be no doubt that persons skilled in the art would understand that Applicant’s had possession of embodiments utilizing non-fluorescent pigments, as claimed, at the time the instant application was filed. *See, e.g., In re Anderson*, 176 USPQ 331, 336 (CCPA 1973), for the proposition that in determining whether an amendment to a claim constitutes new matter, the question is not whether the added words are words that are used in the application as filed, but whether the concept embodied by the added words is present in the original specification. The concept embodied by “non-fluorescent” pigment is found in the original specification as explained, therefore, in view of *Anderson*, the amendment of the claims to introduce the words “non-fluorescent” does not introduce new matter.

The Examiner appears to adopt a per se position that any new negative limitations *necessarily* introduce new concepts and, thus, new matter, citing *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983). However, there is nothing inherently ambiguous or uncertain about

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negative limitations, so long as the boundaries of the patent protection sought are set forth definitely and the negative limitation has a basis in the original specification as filed. *See MPEP* §2173.05(j). The negative limitation introduced here has a basis in the original specification, as discussed above.

Moreover, it is interesting to note that *Ex parte Grasselli*, in turn, relies on *In re Anderson* which is discussed herein above. Again, *In re Anderson* stands for the proposition that a lack of express support is not determinative, but rather the question is whether the *concept* embodied by the added word is present in the original specification. In *Ex parte Grasselli*, there was no support in the original specification for the concept embodied by the added negative limitation, and therefore relying on *In re Anderson*, the negative limitations did, in fact, introduce new matter. In the present case, however, as Applicants have explained above, the concept embodied by the added negative limitation is supported by the original specification as filed as evidenced by, for example, original claims 3 and 17, which specify types of non-fluorescent pigments. Therefore, unlike the situation in *Ex parte Grasselli*, there is support for the concept embodied by the added negative limitation and therefore, relying on *In re Anderson*, the negative limitation addition should be allowed.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this objection. An early notice that this rejection has been reconsidered and

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withdrawn is earnestly solicited.

Claims 1, 2, 4-8, 15, 16, 18-22 and 29 were rejected under 35 USC § 102(e) as being anticipated by Zhu, U.S. Patent No. 6,251,175, taken in view of the evidence in either EP 1219462 or Wexler, U.S. Patent No. 6,454,896. In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, the absence in the prior art reference of even a single one of the claim elements is sufficient to negate anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Also, it is not enough that the single prior art reference discloses all elements in the claim in isolation; rather the elements must be "*arranged as in the claim.*" *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The arrangement required by the instant claims is that the *water soluble* compound comprises part of a *non-aqueous* lamination ink formulation or dispersion. There is no specific teaching of such an arrangement in Zhu. Consequently, Zhu cannot anticipate the instant claims.

While Zhu's ink must comprise an organic solvent, it is not necessarily non-aqueous since Zhu teaches at column 3, lines 24-26, that "[s]mall quantities of water can also be used in the carrier to provide the necessary electrical conductivity when using non-aqueous solvents as the ink jet carrier." To the extent that Zhu discloses water soluble compounds, a person having

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ordinary skill in the art would be reasonable to expect that these water soluble compounds are to be included in Zhu's aqueous embodiments. There is no specific teaching in Zhu, including the examples, of any *non-aqueous* embodiment necessarily including a *water soluble compound*, as instantly claimed.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 1, 3-10, 12, 13, 15, 17-24 and 26-29 were rejected under 35 USC § 102(e) as being anticipated by Trauernicht et al., U.S. Patent No. 6,247,801, taken in view of the evidence in either EP 1219462 or Wexler, U.S. Patent No. 6,454,896. In response, Applicants point out that this rejection suffers the same defect as the previous rejection. Thus, Trauernicht's inks can be aqueous as well. See, Trauernicht at column 2, lines 36-37 ("[t]he solvent used may also be a mixture of water and . . ."), and lines 53-54 ("[w]hen a mixture of an organic solvent and water is used . . ."). Also, there is, again, no specific teaching in Trauernicht, including the examples, of any *non-aqueous* embodiment necessarily including a *water soluble compound*, as instantly claimed.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to

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reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 1-3, 5, 7-10, 15-17, 19, 21-24 and 29 were rejected under 35 USC § 102(b) as being anticipated by Mead et al., U.S. Patent No. 5,596,027, taken in view of the evidence in either EP 1219462 or Wexler, U.S. Patent No. 6,454,896. In response, Applicants point out that this rejection suffers the same defect as the previous rejections. Thus, Mead's inks can be aqueous as well, and, indeed, aqueous inks are preferred. See, Mead at column 4, lines 36-39 ("[a]ny suitable ink carrier, including aqueous and non-aqueous carriers . . . Water is a preferred ink carrier."). Also, there is, again, no specific teaching in Mead, including the examples, of any *non-aqueous* embodiment necessarily including a *water soluble compound*, as instantly claimed.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 1, 11, 15, 23, 25 and 29 were rejected under 35 USC § 102(b) as being anticipated by Johnson et al., U.S. Patent No. 5,922,118, taken in view of the evidence in either EP 1219462 or Wexler, U.S. Patent No. 6,454,896. In response, Applicants point out that this rejection

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suffers the same defect as the previous rejections. Thus, Johnson's inks can be aqueous as well, and, indeed, aqueous inks are preferred. See, for example, Johnson at column 9, lines 51 ff ("The modified colored pigments . . . of the present invention are also useful in aqueous ink and coating formulations."). Also, there is, again, no specific teaching in Johnson, including the examples, of any *non-aqueous* embodiment necessarily including a *water soluble compound*, as instantly claimed.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

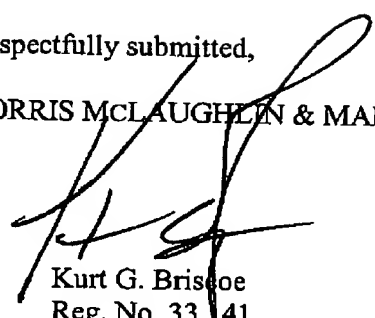
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Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By


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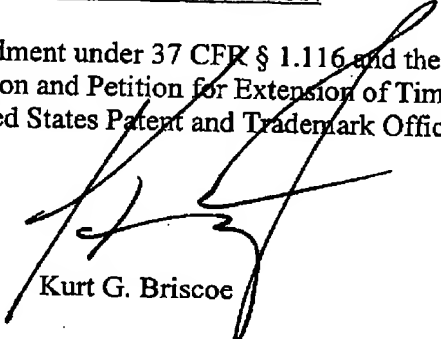
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 and the accompanying Request for Continued Examination and Petition for Extension of Time (15 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: January 21, 2005

By:


Kurt G. Briscoe